

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/798,140
Appeal No. : 2008-6111
Inventor(s) : Domenic V. Apprille, Jr.
Filed : March 11, 2004
Art Unit : 3724
Examiner : Sean M. Michalski
Docket No. : 8127/Z-03370
Confirmation No. : 5560
Customer No. : 27752
Title : Dispensers for Razor Blade Cartridges

REQUEST FOR REHEARING AFTER DECISION BY THE BOARD OF PATENT APPEALS
AND INTERFERENCES UNDER 37 CFR §§ 41.50(b)(2) AND 41.52

Board of Patent Appeals and Interference
US Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

The Board of Patent Appeals and Interferences issued a New Ground of Rejection in the Decision on Appeal rendered on February 11, 2009. Pursuant to 37 CFR §§ 41.50(b)(2) and 41.52, Appellant hereby submits a Request for Rehearing of the Decision.

Rejection Under 35 USC §112, First Paragraph

In the Decision on Appeal, the Honorable Board reversed the rejection of claim 67 under 35 U.S.C. § 103(a) as being unpatentable over Kohring, Petricca, and Rozenkranc. The Board stated: “the Examiner has not made a sufficient showing that clips 40 and tops 47 of Petricca are protective in nature and will not damage a trimming blade upon contact.” (Decision on Appeal mailed on February 11, 2009, p. 12, ¶¶ 1-2). However, pursuant to 37 CFR §§ 41.50(b), the Board issued a new ground of rejection, namely Appellant’s claim 67 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. (Id. at ¶ 3). In

particular, the Board alleges that Appellant's specification does not specially define any limiting structural meaning for the terms "stabilizing feature" and "protective feature." (Id.). Applicant respectfully traverses the rejection.

In re Wright establishes that the Examiner, or in this case, the Board, has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. (*In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993); see also MPEP § 2164.04). According to MPEP § 2164.04, before any analysis of enablement can occur, it is necessary for the Examiner to construe the claims. Any terms that are not well-known in the art, or for terms that could have more than one meaning, it is necessary that the Examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action. (MPEP § 2164.04; see also *Genentech v. Wellcome Foundation*, 29 F.3d 1555, 1563-64 (Fed. Cir. 1994)). Furthermore, a specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. In *In re Marzocchi*, the court stated: "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." (*In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971); see also MPEP § 2164.04).

In compliance with the enablement requirement, Appellant's specification and/or drawings contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented. In particular, the specification states:

The dispenser further includes *a stabilizing feature*, disposed on an upper edge of at least some of the cartridge dividers, constructed to engage the cartridge connecting portion and restrict movement of the cartridge connecting portion within an upper opening of the corresponding section. The dispenser further includes *a feature*, disposed on the upper edge, constructed to *prevent contact between the stabilizing feature and a rear edge of the cartridge*. The rear edge may include a trimming blade assembly. The upper edge is radiused to prevent contact between the stabilizing feature and the rear edge of the cartridge. (Specification, p. 3, lns. 3-10).

As stated above, Appellant describes the location and function of a “stabilizing feature” as well as a “feature,” a.k.a. “protective feature,” to prevent contact between the stabilizing feature and a rear edge of the cartridge. Appellant’s specification further includes more details of the “stabilizing feature” and the “protective feature.” (See below). However, instead of using the term “feature” or “protective feature,” Appellant describes a specific type of “protective feature,” namely a rib, which may be used. As such, the specification also states:

Referring to FIGS.1 and 6, the inner surface 130 of each angled divider portion 42 includes several features adjacent the top edge 132 of the divider. *A stabilizing feature 134* is centrally located along each top edge 132. Stabilizing feature 134 is constructed to abut the outer forward surface 136 of the cartridge connecting structure 16 when the cartridge is in the section 20, as shown in FIGS. 1A and 9. The stabilizing feature 134 inhibits movement of the connecting structure 16 along the long axis of the dispenser, reducing the angular rotation of the connecting structure 16 relative to the blade unit during movement of the dispenser. The stabilizing feature 134 also maintains the connecting structure 16 at a desirable angle for insertion of the handle connecting structure of a handle. A pair of raised ribs 138 are disposed adjacent each top edge 132, near the side walls 26. As shown in FIG. 6, these ribs 138 extend further from surface 130 than does the stabilizing feature 134. As a result, *ribs 138 protect the trimming blade 504 from contact with the stabilizing feature 134 during insertion and withdrawal of the cartridge*. Preferably, the ribs 138 extend at least 0.75 mm, preferably 0.85 to 1.0 mm, beyond the stabilizing feature in all directions. The top edge 132 is also preferably curved (FIG. 3) to minimize damage to the trimming blade. (Specification, p. 11, ln. 27-p. 12, ln. 11).

Clearly, the specification supports the structural meaning for the terms “stabilizing feature” and “protective feature.” The Board’s enablement rejection is clearly flawed and the initial burden, under MPEP § 2164.04, of providing sufficient reason to doubt the objective truth

Appl. No. 10/798,140
Docket No. 8127/Z-03390
Request dated March 27, 2009
Reply to Decision mailed on February 11, 2009
Customer No. 27752

of the statements contained therein has not been met. Accordingly, claim 67 complies with the enablement requirement under 35 U.S.C. 112, first paragraph.

Conclusion

In view of all of the above, it is respectfully submitted that the Honorable Board of Patent Appeals and Interferences reverse the rejection of claim 67 and remand the application with instructions that the claim be allowed.

Respectfully submitted,

THE GILLETTE COMPANY



By

Brion A. Berman
Registration No. 57,935
(617) 421-7933

Date: March 27, 2009
Customer No. 27752